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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,087	03/11/2004	Koji Kobayashi	04536.032001	6040
22511	7590	11/29/2007	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			DANG, HUNG Q	
			ART UNIT	PAPER NUMBER
			2621	
			NOTIFICATION DATE	DELIVERY MODE
			11/29/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/798,087

Applicant(s)

KOBAYASHI, KOJI

Examiner

Hung Q. Dang

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                                 |                                                                                         |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____                                                |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/11/2004, 09/06/2006, 01/03/2007.

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 11/13/2007 have been fully considered but they are not persuasive.

At page 3 of Remarks, regarding claim 1, Applicant argues that Hamada does not disclose "(1) storing information of a position of reproduction at a time point of input to said first input unit when data is being reproduced by said data reproduction unit, and (2) generating a thumbnail image of a still picture at a position of reproduction in response to an input at said first input unit when data is not being reproduced by said data reproduction unit."

In response, the Examiner respectfully disagrees. As illustrated in Fig. 1, Hamada discloses a recording and reproduction apparatus that allows users to select a Playlist to be reproduced and to place a bookmark at a desired scene ([0142]). To place a bookmark, the user acts on a mark button, which is the first input unit ([0143]). Accordingly, a thumbnail picture is specified to mark the desired scene as described in [0143], [0144] and further illustrated in [0017] and Fig. 12. Fig. 11 illustrates a record of such a mark. Within this record, a mark\_time\_stamp entry is used to indicate the marked position as described in [0118] and shown in Fig. 12. In other words, the information of a position of reproduction is the mark time point. Note that the action of placing the bookmark can be performed during playback, i.e. when data is being reproduced by the reproduction unit (see [0142]). Also in [0142], Hamada recites, "the user views the AV stream being reproduced to search a scene desired to be marked."

When the scene is found, Hamada recites, "he or she acts on a mark button of a remote controller ..." So it is very clear to one of ordinary skill in the art, when the mark button is acted on, the current position of reproduction is marked and this is the mark time point as described in [0118]. The purpose of doing this is to allow a user to come back to reproduce from the marked location at a later time (see [0117] as Hamada recited, "in reproducing the Playlist, random access may be made using the mark in the Clip being referenced by the Playlist"). The information regarding to these marks is then stored into a database as described in [0080], [0081], and [0082].

For that reason, the Examiner respectfully submits that Hamada clearly discloses "(1) storing information of a position of reproduction at a time point of input to said first input unit when data is being reproduced by said data reproduction unit".

Further, in [0143] Hamada recites, "if a mark button is acted on by the user at step S3, the mark position is determined ... If the mark position is set, a picture which is to be a thumbnail picture is selected at step S5". In other words, Hamada recites when the user acts on a mark button to set a mark position, a thumbnail is going to be selected to represent the markers. Paragraphs [0144] and [0145] describe the process of generating the thumbnail image together with its associated information. Paragraph [0143] further discloses that the process of generating the thumbnail is initiated "at a time point when the mark position is specified". Obviously, the action of specifying the mark position is in response to the action of a mark button being acted on in [0143] (corresponds to the input to said first input unit). Finally, in [0142], Hamada discloses

the operation of book-marking or scene-marking can be performed during the playback of the data is paused, i.e. when the data is not being reproduced.

Thus, Hamada obviously discloses "(2) generating a thumbnail image of a still picture at a position of reproduction in response to an input at said first input unit when data is not being reproduced by said data reproduction unit."

In conclusion, the claims stand rejected as previously presented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamada et al. (US 2002/0135608).**

Regarding claim 1, Hamada et al. disclose a disk reproduction apparatus ([0022]; [0097]) comprising: a data reproduction unit reproducing data recorded on a disk ([0142]; [0097]); a first input unit accepting a predetermined input ([0129]); a marker display unit causing a display device to display a plurality of marker when there is an input at said first input unit during reproduction of data by said data reproduction unit ([0129]); a second input unit accepting input of information selecting one marker from said plurality of markers displayed at said display device ([0142]; [0126]; [0131]); an information storage unit storing, in association, information of displaying said selected marker and information of a position of reproduction on a disk in said disk reproduction

unit at a time point of input to said first input unit, in response to input to said second input unit ([0142]; [0145]; [0115]) when data is being reproduced by said data reproduction unit (during "playback" in [0142]); a thumbnail generation unit generating a thumbnail image of a still picture at a position of reproduction on said disk associated with said information of displaying a marker in said information storage unit, in response to an input at said first input unit ([0142]; [0143]; [0144]) when data is not being reproduced by said data reproduction unit (during "pause" in [0142], "pause" operation is a temporary or short-time stop); and a thumbnail display unit causing said display device to display the thumbnail image generated by said thumbnail generation unit ([0129]; [0164]).

Claim 4 is rejected for the same reason as discussed in claim 1 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al. (US 2002/0135608) as applied to claims 1 and 4 above, and further in view Chiu et al. (US Patent 6,452,615).**

Regarding claim 2, see the teachings of Hamada et al. as discussed in claim 1 above. Further, Hamada et al. also disclose said data reproduction unit causes said display device to display a picture of the data to be reproduced ([0142]). However,

Hamada et al. do not disclose said marker display unit displays said marker at an area on a display region of said display device.

Chiu et al. disclose a marker display unit displays markers at an area on a display region of a display device (Fig. 1; Fig. 3; column 5, lines 57-61).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the displaying of markers at an area on a display region of a display device disclosed by Chiu et al. into the disk reproduction apparatus disclosed by Hamada et al. to facilitate the reviewing and setting the markers; hence, enhancing the user interface of the apparatus.

Regarding claim 3, Chiu et al. also disclose reproduction control unit causing a data reproduction unit to execute a reproduction operation from a position of reproduction on a disk associated with information of displaying a selected marker in a information storage unit in response to input to an input unit when said thumbnail image is displayed at a display device (column 6, lines 35-42).

Claim 5 is rejected for the same reason as discussed in claim 2 above.

Claim 6 is rejected for the same reason as discussed in claim 3 above.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is 571-270-1116. The examiner can normally be reached on M-Th:7:30-6:00.

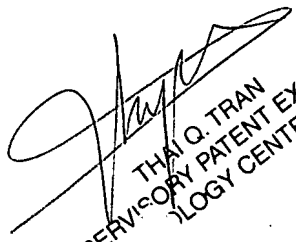
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/798,087  
Art Unit: 2621

Page 8

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung Dang  
Patent Examiner



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